

REMARKS

Applicants have carefully reviewed this Application in light of the Final Office Action mailed January 5, 2004 and the Advisory Action mailed March 30, 2004. Claims 33, 35, 37, 38, 40, 42, 43, and 71-95 are pending in this Application. Claims 33, 35, 37-38, 40 and 71-91 stand rejected under 35 U.S.C. §102(e) and Claims 42-43 and 92-95 stand rejected under 35 U.S.C. §103. Applicants wish to thank the Examiner for taking the time to discuss the application in a telephone interview. Applicants have provided remarks in accordance with the Examiner's comments during the telephone interview. Applicants respectfully request reconsideration and favorable action in this case.

Rejections under 35 U.S.C. § 102

Claims 33, 35, 37-38, 40 and 71-91 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent 6,498,841 issued to Rex Norman Bull et al. ("Bull").

Bull discloses a method and system for providing audible call notification of a current call and a subsequently received call waiting call to a called party. In Bull, a called party, on an existing telephone call or upon answering a current call, is provided an enhanced call waiting message that includes a call waiting indicator and an audible representation of caller ID information, i.e., a text-to-speech conversion of the calling number and the party associated with the calling number or an identifying utterance obtained from the calling party. (Col. 8, Lines 58-65). In addition, the called party is presented with calling party's standard caller ID information on any Type II caller ID customer premises equipment, i.e., equipment capable of receiving both standard caller ID and caller ID for call waiting information, in use by the called party. (Col. 10, Lines 34-40). During an existing telephone call or upon answering a current call, the called party is also presented with a set, audible listing of call disposition options from which the called party may select to dispose of a call waiting or current call. (Col. 9, Lines 7-35).

Claim 33 recites a method comprising the step of "automatically transmitting a message from the mediation system to the communication device of the called party, wherein the message includes the list of follow-through options to be displayed on the communication device of the called party for selection by the called party."

Claim 81 recites a program product including a mediation system that performs operations comprising "automatically transmitting a message from the mediation system to

the communication device of the called party, wherein the message includes the list of follow-through options to be displayed on the communication device of the called party for selection by the called party.”

Applicants respectfully submit that the cited reference fails to disclose each and every element of Applicants’ invention. Bull fails to teach a method for facilitating mediated virtual communication comprising the step of “automatically transmitting a message from the mediation system to the communication device of the called party, wherein the message includes the list of follow-through options to be displayed on the communication device of the called party for selection by the called party,” as recited by Claim 33. Bull also fails to disclose or suggest a program product including a mediation system that performs operations comprising “automatically transmitting a message from the mediation system to the communication device of the called party, wherein the message includes the list of follow-through options to be displayed on the communication device of the called party for selection by the called party,” as recited by Claim 81.

Specifically, Bull does not disclose displaying a list of follow-through options on the communication device of the called party for selection by the called party. Instead, Bull only discloses that disposition options are provided to a called party by audible instructions. (Col. 9, Lines 7-14). In contrast, Applicants written description teaches that contextual information, including, but not limited to, the mediated party name, phone number of the mediated party, reason for the communication and prior attempts of the mediate party to contact the mediated subscriber, may be used to provide the mediated subscriber with a summary of the communication. (Specification, Page 17, FIGURE 6 and Table 1). The contextual information then may be used to determine how to handle the communication, for example, by creating a list of follow-through options that are displayed on the communication device and selected by the mediated subscriber. (Specification, Pages 17-18 and FIGURE 6). The cited reference fails to disclose the recited limitations and, therefore, cannot anticipate Claims 33 and 81.

Given that 35, 37, 38, 40, and 71-80 depend from independent Claim 33 and Claims 82-91 depend from independent Claim 81, Applicants respectfully submit that Claims 35, 37, 38, 40, 71-80 and 82-91 are allowable. As such, Applicants respectfully request that the Examiner withdraw the rejections and allow Claims 33, 35, 37, 38, 40, and 71-91.

Rejections under 35 U.S.C. § 103

Claims 42-43 and 92-95 were rejected under 35 U.S.C. §103(a) as being unpatentable over Bull in view of U.S. Patent 6,477,240 issued to Kang S. Lim et al. (“Lim”).

Lim discloses a unified messaging system. As described in Lim, a unified messaging system unifies the various communication services that have, up to now, existed as separate services and permits a user to employ a single device, e.g., a telephone, to access the various communication services such as facsimile, page, email and the like. (Col. 6, Lines 12-17). The unified messaging system of Lim is operable to receive a variety of communication connections, identify the type of communication being attempted, e.g., fax, email, page, voice, etc., and to process the communication connected in accordance with preexisting user communication option settings and without user intervention in all circumstances.

Claim 92 recites a program product including a mediation system that performs operations comprising “transmitting a text-based message from the mediation system to the communication device of the user, such that the text-based message causes the communication device to display the list of follow-through actions for selection by the user.”

Claim 94 recites a method comprising the step of “transmitting a text-based message from the mediation system to the communication device of the user, such that the text-based message causes the communication device to display the list of follow-through actions for selection by the user.”

Applicants respectfully submit that the cited references fail to disclose every element of Applicants’ invention as amended. Further, there is no motivation, teaching, or suggestion to combine Bull and Lim. Bull and Lim, alone or in combination, fail to teach at least “transmitting a text-based message from the mediation system to the communication device of the user, such that the text-based message causes the communication device to display the list of follow-through actions for selection by the user,” as recited by Claim 92. Additionally, Bull or Lim fail to teach a method comprising the step of “transmitting a text-based message from the mediation system to the communication device of the user, such that the text-based message causes the communication device to display the list of follow-through actions for selection by the user,” as recited by Claim 94. The cited references, therefore, fail to disclose the recited limitations and cannot render obvious Claims 92 and 94.

Given that Claim 93 depends from independent Claim 92 and Claims 42, 43 and 95 depend from independent Claim 94, Applicants respectfully submit that Claims 42, 43, 93

and 95 are allowable. As such, Applicants respectfully request that the Examiner withdraw the rejections and allow Claims 42, 43 and 92-95.

Information Disclosure Statement

Applicants enclose a new Information Disclosure Statement and PTO Form 1449 for the Examiner's review and consideration. Applicants received an Office Action in co-pending Application Serial Number 10/096,261 filed March 12, 2002 (Attorney Docket No. 073612.0111) and co-pending Application Serial Number 09/829,784 filed April 9, 2001 (Attorney Docket No. 073612.0105), where the Examiner for each application cited new references. Applicants submit these references for consideration in this application.

CONCLUSION

Applicants appreciate the Examiner's careful review of the application. Applicants have now made an earnest effort to place this case in condition for allowance in light of the amendments and remarks set forth above. For the foregoing reasons, Applicants respectfully request reconsideration of Claims 33, 35, 37, 38, 40, 42, 43, and 71-95.

Applicants enclose a Petition for One-Month Extension of Time along with a check in the amount of \$55.00 for the filing fee (Small Entity), and enclose a check in the amount of \$385.00 for the RCE fee required under 37 C.F.R. 1.17(e).

Applicants believe no further fee is due for this response, however, if any additional fees are due, the Commissioner is hereby authorized to charge any necessary fees to Deposit Account No. 50-2148 of Baker Botts L.L.P.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicants' attorney at 512.322.2581.

Respectfully submitted,
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Date: May 5, 2004

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512.322.2581
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Attachment(s):

1. Request for continued Examination (RCE) Transmittal, along with a check in the amount of \$385.00 (small entity) filing fee
2. Petition for One-Month Extension of Time, along with a check in the amount of \$55.00 (small entity) filing fee
3. Information Disclosure Statement and PTO Form 1449 w/references